## Remarks

### I. Status of the Application

Claims 1, 4-12, and 29-31 are pending in the application. Claims 1, 6, 9 and 29 are amended. Claim 12 is cancelled, without prejudice. Claims 30-31 are added.

The Examiner is thanked for discussing the application with the undersigned attorney on January 31, 2006. The Examiner stated that changing "processor" to "computer" would overcome the rejection under 35 U.S.C. § 101. The cited prior art was discussed but no other agreement was reached.

### II. Claims Rejections - 35 USC § 101

Claims 1, 4-13, and 29 have been rejected under 35 U.S.C. 101 as being allegedly directed to non-statutory subject matter. Claims 1 and 9 have been amended and the rejection is respectfully traversed.

As discussed during the Interview and above, the term"processor" has been changed to "computer" in claims 1 and 9. While not agreeing that such amendments are necessary in light of Ex parte Carl A. Lundgren, Appeal No. 2003-2088 (Bd. Pat. App. & Interf. 2005), such amendments have been made herein to advance prosecution of the application.

Withdrawal of the rejection and reconsideration of the claims are respectfully requested.

### III. Claim Rejections - 35 USC § 112

Claim 29 has been rejected under 35 U.S.C. 112 as being allegedly indefinite. Claim 29 has been amended and the rejection is respectfully traversed.

Claim 29 has been amended to recite "identifying investment-preference information associated with the user in response to receiving the request, wherein the investment-preference information further includes a first investment account and a second investment account, the first investment account and the second investment account being designated by the user." As amended, this limitation clearly falls within the scope of the "identifying" limitation of amended claim 1 and thus is not indefinite.

The Examiner has also stated on page 4 of the Office Action that the "first"and "second" investment "choices" recited in claim 29 are in fact the second and third investment choices claimed. Amended claim 29 now recites a first investment "account" and a second investment "account," as discussed above. Support for the amendment to claim 29 is found at page 16, lines 1-16.

## IV. Claim Rejections - 35 USC § 103

Claims 1, 4-13 and 29 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over U.S. Patent No. 6,112,191 ("Burke") in view of U.S. Patent No. 6,164,533 ("Barton"). Claims 1, 9, and 29 have been amended and the rejection is respectfully traversed.

### A. Claim 1

In an example of an implementation of the invention, a user is able to contribute to one or more investment accounts, such as a retirement account, by using a debit or credit card, after completion of a point of sale transaction, such as a purchase at a store or a transaction at an ATM, for example.

Claim 1, which defines a method for effectuating an investment, has been amended to require "completing a point-of-sale transaction by a user at a point of sale location," and receiving, "a request to complete an on-demand investment transaction after completion of the point-of-sale transaction." Support for this amendment is found at page 14, lines 1-5, for example, which states that: "Once the point-of-sale transaction [here, an ATM transaction] is complete, including any amount of money that is to be transferred from the customer's purchase account to the merchant's bank account, as cash-back to the customer, the investment process will begin." The ATM can be programmed to display a prompt asking the customer whether they desire to make an on-demand investment "upon completion of their withdrawal (or other point-of-sale transaction, such as a balance inquiry.)." (Page 14, lines 1-11; See also page 5, lines 13-16, for example).

Claim 1 has also been amended to recite a "predetermined monetary investment amount" instead of a predetermined "dollar" investment amount. Support for this amendment is found at page 15, lines 1-5, for example. This amendment has not been made in response to a rejection and does not limit the scope of the claim.

Requiring that the "request" to complete an investment transaction be received after completion of the point-of-sale transaction, as in amended claim 1, is a very important consideration for merchants and banks, which is not taught or suggested in the cited prior art. Since the request is received after completion of the point of sale transaction, the point-of-sale transaction and the investment transaction are two separate transactions. If the investment transaction is part of the point-of-sale transaction, as in the cited prior art discussed below, the

risk of delay and/or interruption of the clearance and settlement of the point-of-sale transaction is increased.

In accordance with current industry practice, credit card processors, such as VisaNet®, are offering authorization times of less than two seconds. While generally sufficient to complete standard credit card transactions, two seconds may not be sufficient to complete combined purchase and investment transactions in a timely and consistent manner. A combined purchase and investment transaction system would cause a delay in many (if not all) purchase transactions because, in addition to conducting the purchase transaction, it would also be necessary to retrieve the purchaser's investment account information, determine whether or not the purchaser is a subscriber of the investment contribution program, retrieve the purchaser's investment preference information, and modify the pending point-of-sale transaction to include any applicable investment amount, prior to completing the combined transaction. The additional steps increase the time required to conduct the combined transaction and the risk of error.

Separately processing the investment transaction and the point-of-sale transaction amount also reduces the risk that a user's credit limit may be exceeded by the combined total of the point-of-sale and investment transactions, and therefore increases the probability that at least the point-of-sale transaction may be completed, which is the primary concern of the merchant and the bank. If the addition of an investment contribution amount to a point-of-sale transaction amount causes the user's credit limit to be exceeded, completion of the point-of-sale transaction would be slowed and possibly declined in the prior art. Avoiding such problems is very important to the merchant, the bank, and the user.

Separately processing the investment transaction and the point-of-sale transaction also generates simpler accounting data for credit card issuers, banks, and the merchants. For example, if the point-of-sale transaction and the investment transaction are combined, as in the prior art, a merchant must be able to efficiently distinguish between the point-of-sale transaction amount, to which the merchant is entitled, and the transaction amount, to which the merchant is not entitled. This may be difficult for some merchants. Separating the transactions also avoids confusion concerning the transaction amount where, for example, the purchaser returns the goods to the merchant.

Neither Burke, Barton, nor the other cited references, individually or in combination, teach or suggest "receiving from the point-of-sale location, by a computer, a request to complete an on-demand investment transaction after completion of the point-of-sale transaction," as required by amended claim 1.

Burke discloses a method of accumulating credits in a consumer's surplus accounts from financial transactions between a consumer and a merchant, in which an "excess amount" for investment is added to a purchaser's "transaction amount" to create a "total withdrawal." (Col. 11, lines 37-39; Col. 14, lines 28-34; Col. 15, lines 15-19; Col. 16, lines 34-35). The purchaser decides how much money to add to the purchase price for investment (the "excess amount"). The excess amount is allocated among various accounts previously specified by the consumer, and the total withdrawal (purchase amount and investment amount) is cleared by the bank during the point-of-sale transaction. (Col. 11, lines 39-43; Col. 13, lines 31-34; Col. 14, lines 16-31; Col. 15, lines 20-21; Col. 16, lines 36-37). There is no teaching or suggestion that the

"investment transaction" in Burke is either "requested," or conducted, after completion of the point-of-sale transaction, as claimed.

Barton discloses a system for automatically contributing monies to a savings program ("AutoIRA") upon making a purchase, wherein charges are tallied to include "the amount of purchase, local and government taxes, and AutoIRA contribution," which may consist of 1%-5% of the purchase amount. (Col. 4, lines 20-24; Col. 5, lines 63-66). The "debit/deduction is made to the individual card holder's account for purchases made including the IRA contribution." (Col. 6, lines 7-9). Charges are tallied in the same manner in other examples disclosed in Barton, as well. (Col. 7, lines 1-3, 11-13; Col. 8, lines 10-12; 21-23; steps 6, 7, Figs. 1, 2, 3.). Barton, therefore, also combines the point-of-sale transaction and the investment transaction. There is no teaching or suggestion in Barton that the "investment transaction" is either "requested," or conducted, after completion of the point-of-sale transaction, as claimed, either.

The systems in both Burke and Barton are therefore susceptible to the problems discussed above.

For the reasons set forth above, amended claim 1 and its dependent claims (4-8, 12-13 and 29) are patentable over the cited art. The dependent claims also recite patentable limitations.

**B. Claim 9**

Amended claim 9 requires "prompting a user at a point-of-sale location, to request that an on-demand investment transaction be performed, after completion of a point of sale transaction," and "receiving, by a computer, the request from the user at the point-of-sale location." Amended claim 9 further requires "causing, by the computer, funds to be transferred to an investment account, wherein the funds equal a predetermined monetary investment amount determined

independently of a purchase amount of the point-of-sale transaction, upon receipt of the request from the user."

Neither Burke nor Barton teaches or suggests "prompting a user at a point-of-sale location, to request that an on-demand investment transaction be performed, after completion of a point of sale transaction," or "receiving, by a computer, the request from the user at the point-of-sale location," as discussed above. As such, amended claim 9 and its dependent claims (10-11) are also patentable over the cited art. The dependent claims also recite patentable limitations.

## V. New Claims 30-31

New independent claim 30 requires "completing a first, point-of-sale transaction by a user at a point of sale location," and "receiving, by a computer, a request to conduct a second, separate, on-demand investment transaction after completion of the first, point-of-sale transaction by the user at the point-of-sale location, from the point-of-sale location." Claim 30 further requires "conducting the second, separate investment transaction, by the computer, after receiving the request, by at least in part determining an amount of money to transfer to an investment account by the computer" and "transferring the amount of money to the investment account, by the at least one computer. Support for new claim 30 is found at pages 13-15, for example."

As discussed above, none of the cited art teaches or suggests the limitation "receiving, by a computer, a request to conduct a second, separate, on-demand investment transaction after completion of the first, point-of-sale transaction by the user at the point-of-sale location." (Emphasis added). Therefore, new claim 30 is patentable over the cited art.

New claim 31 depends from new independent claim 30, and further recites "wherein determining the amount of money comprises identifying a predetermined constant monetary amount associated with the user, the predetermined constant monetary amount being determined prior to start of the point-of-sale transaction." New claim 31 is patentable over the cited art by virtue of its dependency on new claim 30. Support for new claim 31 is found at page 15, lines 1-5, for example.

## V. Conclusion

In view of the foregoing, each of claims 1, 4-12, and 29-31, as amended, is believed to be in condition for allowance. Accordingly, reconsideration of these claims is requested and allowance of the application is earnestly solicited.

Respectfully submitted
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Date: March 30, 2006 By: _____

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